



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/177,502	10/23/98	SLATER	6530.00008 0

FINNEGAN HENDERSON FARABOW  
GARRETT & DUNNER  
1300 I STREET N W  
WASHINGTON DC 20005-3315

QM12/1213

EXAMINER  
PEFFLEY, M

ART UNIT  
3739

PAPER NUMBER  
6

DATE MAILED: 12/13/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. 09/177,502	Applicant(s) SLATER, CHARLES R.	
	Examiner Michael Peffley	Art Unit 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 October 1998.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-29 and 40-56 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-29 and 40-56 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

### Attachment(s)

- |   |  |
|---|--|
| 14) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 17) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 15) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 18) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 16) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> | 19) <input type="checkbox"/> Other: _____                                    |

Art Unit: 3739

It is noted that the instant application is a divisional of parent Application No. 09/354,992, the '992 application being a party in Interference No. 103,765. The judgment of Interference No. 103,765 was against applicants of the '992 application. During interference proceedings, applicants requested permission to file the instant divisional application, with the permission being granted by APJ Pate in Paper No. 41 of the Interference file.

The examiner has consulted with APJ Pate regarding the instant divisional application, particularly with respect to the decision in the aforementioned Interference proceedings, and the following Office action is set forth in accordance with the advice proffered by APJ Pate.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

Claims 24, 25, 28, 29, 40, 41, 44 and 46-56 are rejected under 35 U.S.C. 102(g) based upon claims 1-11 of Patent No. 5,352,222.

Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is

Art Unit: 3739

the first inventor in this country. See *In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

Claims 26, 27, 42, 43 and 45 are rejected under 35 U.S.C. 102(g)/103(a) based upon claims 1-11 of Patent No. 5,352,222.

While Rydell ('222) does not specifically disclose the use of ceramic as the insulative layer in the patented claims, the examiner maintains that using any well known insulation between the metal layers of the Rydell blades would have been an obvious design choice. In particular, Rydell teaches that it is known to provide an insulating ceramic layer upon a metallic substrate in scissors devices (see column 2, lines 20-34). To have used such a ceramic insulative layer in lieu of the disclosed epoxy insulative layer in the patented claims would have been an obvious modification for one of ordinary skill in the art, particularly in view of the teaching of Rydell.

Failure to present claims and/or take necessary steps for interference purposes after notification that interfering subject matter is claimed constitutes a disclaimer of the subject matter. This amounts to a concession that, as a matter of law, the patentee is the first inventor in this country. See *In re Oguie*, 517 F.2d 1382, 186 USPQ 227 (CCPA 1975).

### ***Collateral Estoppel***

Applicant is also informed that claims 24-29 and 40-56 are subject to rejection on the ground of collateral estoppel. Applicant's failure to properly move under 37 CFR 1.633(c)(1) to add a second count to the interference proceedings (i.e. a count drawn to

Art Unit: 3739

the subject matter of the instant application claims) has created the ground of estoppel as set forth in 37 CFR 1.658(c). See MPEP 2363.03 (particularly examples 1-3).

### **Conclusion**

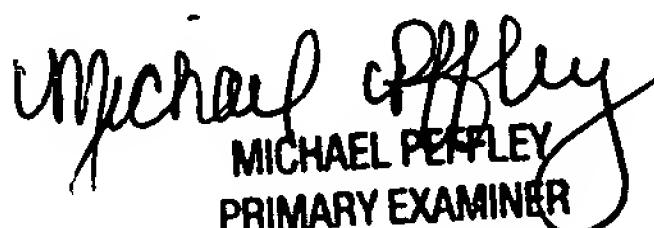
The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Hooven ('166), Goble et al ('975) and Richardson et al ('549) all disclose various other bipolar scissors devices.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Peffley whose telephone number is (703) 308-4305. The examiner can normally be reached on 9 hour.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda M Dvorak can be reached on (703) 308-0994. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

Michael Peffley/mp  
Primary Examiner  
Art Unit 3739  
December 9, 1999

  
MICHAEL PEFFLEY  
PRIMARY EXAMINER  
AU 3739